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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,062	10/22/2003	Rainer Bottesch	SCH-00076	6104

7590 03/08/2005
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EXAMINER

HAN, JASON

ART UNIT PAPER NUMBER

2875

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/691,062	Applicant(s) BOTTESCH ET AL.	
	Examiner Jason M. Han	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-27 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/22/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to Independent Claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 1 is objected to because of the following informalities: Grammatical errors – “adjacent too” and “equal too”. Appropriate correction is required.

The following claims have been rejected in light of the specification, but rendered the broadest interpretation [MPEP 2111].

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Applicant recites in Claim 18, of which Claims 19-20 are dependent upon, the annular reflector being located behind the light-conducting element in beam direction, which contrasts the limitations found in Claims 19-20 with respect to light being transferred from the annular reflector to the light-conducting element. Therefore, the claimed apparatus could not be distinguished with respect to which component the light

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beam strikes first and remains indefinite in structure – the below art rejections are based on the best-deemed interpretation by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al. (U.S. Patent 6447155).

6. With regards to Claim 1, Kondo discloses a lamp for a motor vehicle including:

- A housing [Figure 1: (1)] in which at least one light source [Figure 2: (11, 21)] is arranged, wherein said at least one light source is an LED [Figure 2: (11)]; and
- At least one reflection part [Figure 2: (12, 22)] associated with the light source, wherein the at least one reflection part [Figure 2: (12)] is adjacent to and surrounds the LED and has a height [Figure 2: (14a, 14c)] that is less than or equal to the LED.

The examiner makes further note that it would also be an obvious matter of design choice to change the size of the reflection part to affect the illumination at a desired preference, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Regardless,

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Kondo clearly discloses at least one reflection part [Figure 2: (14a or 14c)] that has a height equal to, if not smaller than, the height of the LED [Figure 2: (11)].

7. With regards to Claim 3, Kondo discloses a reflection part further having a annular reflector [Figure 2: (12-14, 22); see also Figures 3-5]. It should also be noted that a reflection part is inherent of and synonymous with a reflector. Merriam-Webster's Collegiate Dictionary (10th Edition, p. 980) defines a reflector as one that reflects; especially: a polished surface for reflecting light or other radiation.

8. With regards to Claim 4, Kondo discloses a reflector with parabolic configuration [Figures 2, 3, 5: (13)].

9. With regards to Claim 5, Kondo discloses an LED arranged at the focus of the reflector [Figure 2: (f1); see also Figures 3&5].

10. With regards to Claim 6, Kondo discloses a reflector with a surface having optics [Figure 2: (14c); Figure 3: (16a); Figure 4: (16e); Figure 5: (13a, 14e)].

11. With regards to Claim 7, Kondo discloses the reflection part including a light-conducting element [Figure 2: (13, 14); Figure 3: (13, 16); Figure 4: (16); Figure 5: (13, 14)].

12. With regards to Claim 8, Kondo discloses the light-conducting element having a circular outline [Figures 1&6; Figure 2: (12-14); Figure 3: (13, 16); Figure 4: (16); Figure 5: (13, 14)], and at least one light exit side [Figures 1&6; Figure 2: (10, 15); Figure 3; Figure 4: (16b); Figure 5: (13a, 14e)].

13. With regards to Claim 9, Kondo discloses the light-conducting element having a central aperture where the LED is located [Figures 2&3: (11); see also Figure 5].

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14. With regards to Claim 10, Kondo discloses the light-conducting element having reflection surfaces to reflect the light emitted by the LED to a light exit surface [Figure 2: (14a, 14c); Figure 3: (16a); Figure 4: (16a, 16e); Figure 5: (14e)].

15. With regards to Claim 11, Kondo discloses the reflection surfaces coaxial to the LED [Figure 2: (14a, 14c); Figure 3: (16a); Figure 4: (16a, 16e); Figure 5: (14e)].

16. With regards to Claim 12, Kondo discloses reflection surfaces provided on the underside of the light-conducting element [Figure 3: (16a); Figure 4: (16a, 16e)].

17. With regards to Claim 13, Kondo discloses the outside of the light-conducting element provided with at least one reflection layer. To quote, "the reflection portion 14a integrally formed is formed by selective vacuum evaporation of aluminum [Column 3, Lines 25-26]."

18. With regards to Claim 14, Kondo discloses at least two reflection parts arranged closely spaced one behind the other in the beam direction of the LED [Figure 2: (13, 14); Figure 3: (13, 16); Figure 5: (13, 14)].

19. With regards to Claim 15, Kondo discloses one reflection part having an annular reflector [Figure 3: (13); Figure 5: (13)] and the other having a light-conducting element [Figure 3: (16); Figure 5: (14)].

20. With regards to Claim 16, Kondo discloses the annular reflector [Figures 2, 3, 5: (13)] ahead of the light-conducting element [Figure 2: (14); Figure 3: (16); Figure 5: (14)] in the beam direction.

21. With regards to Claim 17, Kondo discloses the annular reflector having a passage opening to admit rays of light to the light-conducting element [Figures 2-5].

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22. With regards to Claim 18, Kondo discloses the annular reflector [Figure 2: (14); Figure 3: (16); Figure 5: (14)] behind the light-conducting element [Figures 2, 3, 5: (13)] in the beam direction.

23. With regards to Claim 19, Kondo discloses the light-conducting element [Figure 2, 3, 5: (13)] including two or more reflection surfaces. It should further be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

24. With regards to Claim 20, Kondo discloses light rays reflected by an annular reflector [Figure 3: (13)] and impinging perpendicularly on the underside of the light-conducting element [Figure 3: (16a)].

25. With regards to Claim 21, Kondo discloses two light-conducting elements arranged one [Figure 2: (20)] behind the other [Figure 2: (10)] in beam direction.

26. With regards to Claim 22, Kondo discloses the anterior light-conducting element including two or more reflection surfaces [Figure 2: (14)] so that the rays of light reflected from the rearward light-conducting element enter the anterior light-conducting element in the region between the two or more reflection surfaces [Figure 2: (14b)].

27. With regards to Claim 23, Kondo discloses the light rays of the rearward light-conducting element impinging perpendicularly [Column 3, Lines 37-54] on the underside of the anterior light-conducting element [Figure 2: (14b)].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (U.S. Patent 6447155) as applied to Claim 1 above, and further in view of Schöniger et al. (U.S. Patent 5136483).

Kondo discloses the claimed invention as cited above, but does not specifically teach the reflection part having a cooling member located on the underside thereof.

Schöniger discloses a reflector [Figure 3: (16)] with cooling members located on the underside thereof [Figure 3: (19)].

It would have been obvious to modify the reflection part of Kondo to incorporate the cooling members of Schöniger to ensure proper heat dissipation for the LED and thereby illumination efficiency.

29. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. (U.S. Patent 6447155) as applied to Claim 14 above.

30. With regards to Claim 26, Kondo teaches two reflection parts corresponding to two different lamps as described above [Figure 2: (10, 20)]. Kondo further teaches a vehicle lamp [Figure 7] with double filaments emitting the same light color.

Kondo does not teach both lamps having an LED.

It would have been obvious to further modify the lamp of Kondo by replacing the incandescent lamp [Figure 2: (20)] with another LED lamp [Figure 2: (10)] with minor adjustments in the reflection surfaces. By doing so will permit a more compact lamp, which would save space and provide for easier installation.

31. With regards to Claim 27, Kondo teaches a combination of lamp units different in color [Column 5, Lines 45-53].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

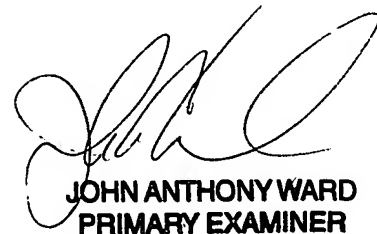
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (3/3/2005)



JOHN ANTHONY WARD
PRIMARY EXAMINER